



1/1

Docket No.: SON-2010
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Hisao Hayashi et al.

Application No.: 09/772,986

Confirmation No.: 2637

Filed: January 31, 2001

Art Unit: 2811

For: THIN FILM SEMICONDUCTOR DEVICE
AND MANUFACTURING METHOD
THEREOF

Examiner: T. F. Tran

REPLY TO ADVISORY ACTION

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Advisory Action dated March 21, 2005.

The Advisory Action indicates that the Amendment filed on December 6, 2004 will not be entered because that amendment is not limited to canceling claims (where cancellation does not affect the scope of any other pending claims) or rewriting dependent claims into independent form (no limitation of a dependent claim can be excluded in rewriting that claim). See 37 CFR 41.33(b) and (c).

Specifically, the Advisory Action contends that the proposed amendment to claims 14 and 16 would raise new issues of claim indefiniteness under 35 U.S.C. §112, second paragraph.

In response, the Final Office Action of March 12, 2004 includes a rejection of claims 1-8 and 13-16, with claims 9-12 being withdrawn from consideration by the Examiner. A review of the Final Office Action reveals that no rejection under 35 U.S.C. §112, second paragraph, has been made against claims 14 and 16 within the Final Office Action.

Moreover, no indication of indefiniteness has been raised within the Examiner's Answer mailed on October 6, 2004.

To eliminate and simplify issues on appeal, and to expedite prosecution of the above-identified application, the Amendment of December 6, 2004 has requested the cancellation of claims 1-8 and 13-16 that are listed within the Appeal Brief, and has requested the cancellation of claims 9-12 that were withdrawn from consideration by the Examiner.

Claim 14 (being dependent upon proposed canceled claim 13) and claim 16 (being dependent upon proposed canceled claim 15) have been placed into independent form within the Amendment of December 6, 2004. No feature found within either finally rejected claim 14 or finally rejected claim 16 has been excluded in rewriting claims 14 and 16 within Amendment of December 6, 2004. Furthermore, no feature absent from either finally rejected claim 14 or finally rejected claim 16 has been added in rewriting claims 14 and 16 within Amendment of December 6, 2004. Instead, that Amendment merely places claims 14 and 16 into independent form to eliminate and simplify issues on appeal, and to expedite prosecution.

Accordingly, the contention made within the Advisory Action that the proposed amendment to claims 14 and 16 would raise new issues of claim indefiniteness under 35 U.S.C. §112, second paragraph may be an introduction of a new ground of rejection that was neither necessitated by the Amendment of December 6, 2004, nor made within the Final Office Action of March 12, 2004.

As a result, it is unclear the how the mere placement of claims 14 and 16 into independent form would produce new issues of claim indefiniteness under 35 U.S.C. §112, second paragraph, that were not previously raised in the Final Office Action or the Examiner's Answer when all features found within those claims were present on the mailing date of the Final Office Action and the Examiner's Answer. Clarification is respectfully requested.

It is also unclear as to why issues of claim indefiniteness under 35 U.S.C. §112, second paragraph, that have not been previously made within the Final Office Action or within the Examiner's Answer are now being raise against claims 14 and 16 at this stage of the prosecution. Clarification is respectfully requested.

It is unclear as to whether or not raising issues of indefiniteness against claims 14 and 16 at this stage of the prosecution is permitted. Clarification is respectfully requested.

In addition, clarification regarding the non-entry of the Amendment of December 6, 2004 is also respectfully requested.

Finally, clarification regarding the status of the Appeal in this application is respectfully requested, as well.

If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone Brian K. Dutton, Reg. No. 47,255, at 202-955-8753 or the undersigned attorney at the below-listed number.

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: March 29, 2005

Respectfully submitted,

By 

Ronald P. Kananen

Registration No.: 24,104

RADER, FISHMAN & GRAUER PLLC

1233 20th Street, N.W.

Suite 501

Washington, DC 20036

(202) 955-3750

Attorney for Applicant